

117 DAC

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: H. Kirk Hammond, Frank J. Giordano
and Wolfgang H. Dillmann
SERIAL NO.: 08/485,472
FILED: June 7, 1995
FOR: GENE THERAPY FOR MYOCARDIAL
ISCHEMIA
ATTY. DKT.: 1279-217C1

RESPONSE TO THE DECISION REFUSING STATUS
UNDER 37 CFR § 1.47(a)CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231.

Date: August 28, 1996

Laura A. Brown
Laura A. Brown

August 28, 1996
201 N. Figueroa St.
Los Angeles, CA 90012

Commissioner of Patents
and Trademarks
BOX DAC
Washington, DC 20231

Sir:

In response to the above Decision Refusing Status Under 37 CFR 1.47(a)
(hereinafter referred to as "Decision"), enclosed are;

1. Declaration of Facts in Support of Filing On Behalf of Named
Inventors - Virginia de la Puente;

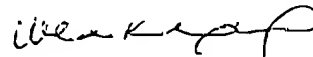
2. Declaration of Facts in Support of Filing On Behalf of Named Inventors - Wean Khing Wong;
3. Documents executed by Wolfgang H. Dillmann;
 - A. Declaration and Petition (original signature);
 - B. Assignment (copy of signature) (the Assignment bearing the original signature is being filed concurrently herewith); and
 - C. Designation of Domestic Representative (original signature);
4. Documents executed by H. Kirk Hammond;
 - A. Declaration and Petition (executed July 26, 1995); and
 - B. Assignment (copy of signature) (the Assignment bearing the original signature is being filed concurrently herewith);
5. Power of Attorney by Assignee (copy), previously filed on September 18, 1995;
6. Associate Power of Attorney;
7. Petition for one month extension of time to respond to "Decision Refusing Status under 37 CFR 1.47(a)"; and
8. Petition Under 37 CFR 1.47(b).

Applicants respectfully submit that the Declarations of Virginia de la Puente and Wean Khing Wong meet the requirements of the Decision. The Assignment of the above-identified patent application to The Regents of the University of California is also hereby properly established. Inventors Frank J. Giordano and Wolfgang H. Dillmann had executed an Assignment to the parent application Serial No. 08/396,207, of which the present application is a continuation-in-part thereof. The executed Assignment recites that the inventors are also assigning their rights to any

continuation-in-part patent application to Serial No. 08/396,207. (See enclosed Declaration of Facts In Support of Filing on Behalf of Named Inventors--Virginia de la Puente, ¶ 5 and its Exhibit B.) Thus, the Power of Attorney by Assignee which was executed by an official of the Regents of the University of California is not defective.

Applicants hereby request expedited prosecution of the application. The Patent Office is encouraged to fax or call the undersigned should there be further questions regarding the Decision.

Respectfully submitted,



Wean Khing Wong
Registration No. 33,561

Tel: (213) 977-1001
Fax: (213) 977-1003

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DECLARATION OF FACTS IN SUPPORT OF FILING ON
BEHALF OF NAMED INVENTORS (37 C.F.R. § 1.47)CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

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201 N. Figueroa St.
Los Angeles, CA 90012

Commissioner of Patents
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Washington, DC 20231

Sir:

This declaration is made as to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the named inventor, Frank J. Giordano, for the above-identified patent application.

This declaration is made by an available person having first-hand knowledge of the facts recited herein.

I. IDENTIFICATION OF PERSON MAKING THIS DECLARATION OF FACTS

Virginia de la Puente
254 Water Street
Point Richmond, California 94801

II. LAST KNOWN ADDRESS OF THE NAMED INVENTOR

Second named inventor: Frank J. Giordano
13119 Caminito Mar Villa
Del Mar, California 92014

III. DETAILS OF REFUSAL OF NAMED INVENTOR TO SIGN APPLICATION PAPERS AND EFFORTS DURING CONVENTION YEAR TO PREPARE APPLICATION AND OBTAIN INVENTOR'S SIGNATURE

1. I am a Licensing Associate, of the Office of Technology Transfer, for University of California, at 1320 Harbor Bay Parkway, Suite 150, Alameda, California 94502.
2. Since at least as early as January 20, 1995, I have been responsible for overseeing the filing, prosecution and licensing of a family of applications which includes the above-identified application. The history of this family of applications is as follows.
3. Initially, a patent application was filed on February 28, 1995, and was assigned Serial No. 08/396,207. The application named the following inventors: H. Kirk Hammond, Wolfgang H. Dillmann, Frank J. Giordano, and Ruben Mestril.
4. Subsequent to the filing of application Serial No. 08/396,207, it was decided *inter alia* to file a continuation-in-part application of application Serial No. 08/396,207, which was filed on June 7, 1995 and was assigned Serial No. 08/485,472.

5. I have in my file, copies of the Declaration and Petition and Assignment for parent application Serial No. 08/396,207 executed by Dr. Giordano on August 10, 1995 (Exhibits A and B, respectively). The assignment provides that assignor will "promptly execute and deliver" any and all papers required "to apply for, obtain, maintain, issue or enforce" the application or "equivalents thereof". The assignor also assigns to the assignee (The Regents of the University of California) all its right, title and interest in "any and all improvements" which are disclosed in the invention found in Serial No. 08/396,207, and which included by its own terms any continuation-in-part application for the invention.

6. I have tried, but failed, to obtain the execution of the Declaration by Inventors (hereinafter referred to as "Declaration") and Assignment of application Serial No. 08/485,472, by co-inventor Dr. Giordano. On June 16, 1995, I spoke with Dr. Giordano regarding signing of the Declaration. Shortly after that date, I sent the application by expedited mail to Dr. Giordano for his review before signing the Declaration. It was my understanding, based on my conversation with Dr. Giordano, that both he and Dr. Dillmann would review the application. On August 10, 1995, I had a telephone conference call with Drs. Giordano and Dillmann, and they had some questions regarding the Declaration. On September 5, 1995, I called Dr. Dillmann to determine the status of the matter. He said he would review the application. On September 7, 1995, I was still working on obtaining the execution of the Declaration and Assignment by Drs. Giordano and Dillmann. On or about September 12, 1995, Dr. Dillmann told me he did not have any specific problems with application Serial No. 08/485,472 but he and Dr. Giordano would not sign the Assignment and Declaration. In at least one of the above telephone conferences, Dr. Giordano told me he would not sign the Declaration and Assignment. On July 9,

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1996, Dr. Dillmann finally did sign both the Assignment and the Declaration. To this date, I have not received the executed Declaration and Assignment from Dr. Giordano.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: August 20th, 1996

Virginia de la Puente
Virginia de la Puente

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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and Wolfgang H. Dillmann

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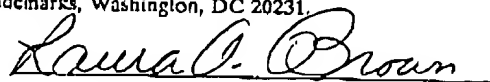
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DECLARATION OF FACTS IN SUPPORT OF FILING ON
BEHALF OF NAMED INVENTORS (37 C.F.R. § 1.47)

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

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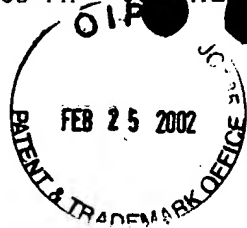

Laura A. Brown

August 28, 1996
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Los Angeles, CA 90012

Commissioner of Patents
and Trademarks
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Washington, DC 20231

Sir:

This declaration is made as to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the named inventor, Wolfgang H. Dillmann, for the above-identified patent application.



This declaration is made by an available person having first-hand knowledge of the facts recited herein.

I. IDENTIFICATION OF PERSON MAKING THIS DECLARATION OF FACTS

Wean Khing Wong, Esq.
1724 Meridian Avenue
South Pasadena, California 91030

II. LAST KNOWN ADDRESS OF THE NAMED INVENTOR

Third named inventor: Wolfgang H. Dillmann
355 South Nardo Avenue
Solana Beach, California 92075

III. DETAILS OF REFUSAL OF NAMED INVENTOR TO SIGN APPLICATION PAPERS AND EFFORTS DURING CONVENTION YEAR TO PREPARE APPLICATION AND OBTAIN INVENTOR'S SIGNATURE

1. I took over prosecution of the above patent application from patent attorney Mr. Robert Berliner sometime after March 13, 1996. Before that, Mr. Berliner was prosecuting the above patent application on behalf of the prior patent attorney, Dr. John P. Spitals who went on extended sick leave in January of 1996 and subsequently passed away on April 25, 1996.

2. Following up on the Patent and Trademark Office's "Decision Refusing Status Under 37 CFR 1.47(a)" mailed May 31, 1996, I spoke to Dr. Wolfgang H. Dillmann by telephone on July 1, 1996, and asked about the Declaration and Assignment to the above patent application. He indicated that if need be, he would sign the documents.

3. On July 3, 1996, I therefore sent Dr. Dillmann a complete package containing a copy of the patent application, Declaration and Petition [of Inventorship],

Assignment and Designation of Domestic Representative to be signed by Dr. Dillmann. The patent application was enclosed so that he would know which patent application I was referring to and to refresh his memory.

4. On July 11, 1996, I received the Declaration and Petition, Assignment and Designation of Domestic Representative executed by Dr. Dillmann on July 9, 1996. The originally executed Declaration and Petition and Designation of Domestic Representative are attached hereto as Exhibits A and B, respectively. A copy of the originally executed Assignment is attached hereto as Exhibit C (the original of which is being filed concurrently herewith).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: July 22, 1996


Wean Khing Wong